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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,550	08/31/2006	Hidenobu Mikami	1007-034	8917

7590 12/09/2008
James V Costigan
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1185 Avenue of the Americas
New York, NY 10036-2646

EXAMINER

OLADAPO, TAIWO

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,550	Applicant(s) MIKAMI, HIDENOBU	
	Examiner TAIWO OLADAPO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment dated 9/15/2008 has been considered and entered for the record. The amendment does not overcome rejections of previous claims which are hereby maintained.

Rejections of newly added claims are set forth below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4, 7, 23 – 26, are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Willey et al. (US 2004/0092408).

4. In regards to claim 1, Willey teaches grease composition comprising base fluid including a high viscosity index polyalphaolefin base fluid, an additional base fluid selected from mono- and poly-substituted naphthalenes, and an ester base fluid; a metal complex soap thickener and additives including a bismuth oxide extreme pressure agent which anticipates the grease of independent claim 1 [0008]. The base fluids can be blended to provide a composition having viscosities @ 40°C of i.e. 200 cSt, which is within the range specified for the base oil [0133; Test

Art Unit: 1797

Grease 6]. Since the composition contains thickeners which increases the viscosity of the composition, the viscosity of the base oil within the composition will be less than 200 cSt and within the claimed range for the lubricating composition.

5. In regards to claim 2, Willey teaches the grease comprising 0.1 to 15% bismuth oxide [0008].

6. In regards to claim 4, Willey further teaches that antiwear additives, antigalling additives, or solid film lubricant additives may be added to the grease compositions including bismuth oxide and bismuth sulfate [0118].

7. In regards to claim 7, Willey teaches the grease composition having an alkali metal soap thickener and a polyurea-based thickener [0023] - [0028].

8. In regards to claims 23 – 26, Willey teaches the grease composition wherein the base oil can comprise at least one of ester oil [0008], mineral oil (i.e. naphthalene oil) [0133], ether oil [0071] and polyalphaolefins which when blended can have a viscosity of 200 cSt as previously stated.

Response to Arguments

9. The applicant's arguments filed 9/15/08 have been fully considered but they are not persuasive. The applicant primarily argues that the reference by Willey discusses high viscosity index polyalphaolefin base oils which do not have the viscosity of from 20 to 200 cSt at 40°C. Although, Willey discloses polyalphaolefins having higher viscosity, he also teaches that the lubricant comprises a blend of oils having a combined viscosity that is within the claimed ranges as explained in §4 above. Therefore, the rejection has been maintained.

Art Unit: 1797

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/
Acting SPE of Art Unit 1797